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10/772,200

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EXAMINER

PATS, JUSTIN

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,200	Applicant(s) JONES-MORTON ET AL.	
	Examiner Justin M. Pats	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10,12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. The following is a Final office action. In response to Examiner's communication of 7/7/09, Applicant, on 10/7/09, amended claims 1, 2, 5, 10, 12, and 19. Claims 1–2, 4–8, 10, 12, and 15–19 are pending in this application and have been rejected below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1–2, 4–8, 10, 12, and 15–19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey, *The Selection of Managers for Foreign Assignments: A Planning Perspective*, The Columbia Journal of World Business, Winter 1996, pg. 102–12 in view of Mayer et al., U.S. Pat. Pub. No. 2001/0034630 [hereinafter Mayer] further in view of Applicant's Admitted Prior Art further in view of Rosnow et al., U.S. Pub. 2003/0106039 [hereinafter Rosnow].

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4. As per claim 1, Harvey teaches a method for selecting associates for expatriate assignments comprising: identifying a plurality of associates who may be eligible for expatriate assignments (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage 2, Cluster Candidates);

identifying a first set of candidates from said plurality of associates (*id.*, Pool of Potential Candidates)

administering a plurality of assessments to said first set of candidates (*id.*, Stage Three: Tactical Level, Selection of Candidates, Testing/Assessment);

entering assessment data for a first set of candidates completing said plurality of assessments and preparing candidate selection data for comparing assessment data across all candidates in said first set of candidates, including individual candidate selection worksheets/summaries (pg. 111–112, especially pg. 111, “The focus of [Stage Three] is the assessment of individual candidates to identify those who have optimum personal skills and attributes to fulfill the requirements of the position. This phase will employ selection tools developed to identify qualified candidates. Some of the tools most frequently used are detailed biographical data, standardized tests, work samples, and assessment centers.”; Exhibit 4–5. In order to assess candidates, data regarding said candidate responses or profile data must be entered in some form and prepared such that a comparison and assessment can ensue. For example, if the candidate is given an interview or standardized test, his or her answers are entered either manually on paper (likely the case in Harvey), audibly via tape recorder, or electronically via a computer and prepared for subsequent assessment and comparison

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purposes.);

creating a group of candidates for said expatriate assignments by selecting a subset of candidates from said first set of candidates (pg. 113, "Once the pool of 'acceptable' candidates has been reduced, one additional dimension of the selection needs to be undertaken. Each candidate must be tested and assessed relative to additional skills that would increase the probability of success in his/her new international position. Two candidates may have equally attractive backgrounds/attributes for the assignment; but, to effectively manage in the future, what developmental activities will each candidate have to undertake before rising to another level of responsibility in the organization. The candidate who will need the least additional training might be preferred over the otherwise "equal" candidate.");

establishing a development plan for each candidate in said group of expatriate candidates (pg. 109, "More well-developed international human resource programs will have a defined succession plan for most managerial positions in the company's international operations."; *see also* pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Stage of Family Life-Cycle/ Career Cycle; pg. 112, discussing the importance of the family life-cycle in evaluating potential candidates for foreign assignment in terms of at least cost and adaptation; *see also* pg. 113, "Candidates must be evaluated on their enthusiasm or the intrinsic excitement of a new position overseas; but at the same time, the longrun relocation package and career benefits offered to the candidate must also be assessed."); and

selecting at least one candidate from said group of expatriate candidates for said specific assignment identified from said expatriate assignments (pg. 105, Exhibit 1, Dynamic Selection

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Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Selection).

Harvey does not explicitly teach providing each of said plurality of associates with preview information relevant to a plurality of expatriate assignments, said preview information comprising organization, job description, and career progression information related to said expatriate assignments, which they have reviewed prior to their identification as candidates. Nor does Harvey explicitly teach wherein a plurality of associates have agreed to be considered for said expatriate assignments prior to the receipt of information for a first set of candidates.

Mayer, in the analogous art of matching candidates to available job positions, teaches providing candidates with preview information relevant to a plurality of assignments, said preview information comprising organization and job description information related to said assignments (Mayer, ¶¶ 0065–71, 77–78), and wherein the candidates have agreed to be considered for said assignments prior to the receipt of information for a first set of candidates (Mayer, ¶ 0078, “The candidate can then indicates that he or she is interested in a particular job listing that has been provided with the search results . . . Upon selecting the listing, the employer is notified that a candidate has indicated interest in the available job and the employer receives at least a portion of the candidate profile. Preferably, identifying data corresponding to the candidate is initially withheld (step 84).”).

Harvey does not explicitly teach entering *in a computer* assessment data for said first set of candidates completing said plurality of assessments and preparing *at said computer* a summary report pertaining to candidate selection across all candidates. Mayer teaches these concepts: Potential candidates are prompted to electronically enter information so as to create an

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online profile which provides the employer with assessment data in order to find the best suited candidate by matching candidate profile information to the requirements of a particular position. Finally, a list can be generated of all candidate matches (Mayer, ¶ 0010, “[T]he present invention provides an interactive employment system which allows a candidate to enter profile data, including identification data, and to match their criteria and then view available job postings.”; ¶¶ 0048–52, 60, 62, discussing candidate profile preferences which a matching job profile should contain.”; ¶¶ 0081–83, “The process commences at step 90 where an employer enters job profile data for an available job opening. The data may be stored in job profile database 37. The employer may then conduct a search for possible candidates for a job position by entering search criteria at the web site hosted by server 12 (step 91). The search criteria may incorporate some or all of the data entered above at step 90. The server then compares the entered search criteria to the candidate profiles stored in candidate profile database 36. The server next lists candidates who match the entered search criteria (step 92). All candidates with matching search terms may be listed. The list of matching candidates may be sorted according to the percentage of search terms that match each candidate.”).

Harvey further does not explicitly teach wherein the development plan comprises activities to assist in preparing said candidate for an expatriate assignment. Mayer teaches wherein the development plan comprises activities to assist in preparing said candidate for an assignment via its online training options for candidates (¶ 0013, 41, & 56).

It would have been obvious to one of ordinary skill in the art to modify Harvey to include the teaching of Mayer because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

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separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, automation through use of computers saves an organization time and resources through faster computation and data analysis and arrangement. Also, assisting in the preparation of an assignment increases the candidate's knowledge and therefore the chance for a successful expatriate assignment campaign.

Neither Harvey nor Mayer explicitly teaches previewing career progression information. However, Official Notice was taken, and not since adequately traversed by Applicant, that job postings or listings comprising career progression information were old and well known in the art at the time of the invention. This limitation is therefore considered Applicant's Admitted Prior Art (*see* discussion *infra*, ¶ 24).

It would have been obvious to one of ordinary skill in the art to modify Harvey in view of Meyer to include the teaching of Applicant's Admitted Prior Art because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, the inclusion of career progression information and other benefits of the position may peak the interest of otherwise unwitting observers of the job posting and result in a more robust pool of Applicants for the organization to choose from, hence increasing the chance at finding a quality candidate.

Furthermore, even though Mayer is not explicitly directed to expatriate assignments, expatriate assignments, their details, and the search for candidates to fill these positions was old and well known at the time of the invention as evidenced above by Harvey. Furthermore, even though Mayer does not explicitly teach wherein the candidates are associates, Harvey teaches

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this is its selection of internal associates for expatriate assignments. Because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is in the substitutions of (1) expatriate assignments for the traditional job assignments of Harvey, and (2) associates for the candidates of Harvey. Thus, these instances of simple substitution of one known element for another producing a predictable result render the claim obvious.

Harvey in view of Mayer further in view of Applicant's Admitted Art does not explicitly teach establishing a date for a new product launch; determining a period of years in advance of said date to complete an expatriate associate selection process for expatriate assignments applicable to said new product launch; and within said period of years performing the remainder of the steps of claim 1; which now additionally include determining at said computer specifications for each of a plurality of expatriate assignments for said new product launch, arranging for said group of expatriate candidates to complete said expatriate assignments outside said candidates' home countries and to return to said home countries; and after said period of years and by said date, launching said new product.

Rosnow, in the analogous art of computerized product development (for computer implementation functionality, *see* Rosnow, Figs. 5–6, ¶ 0037), teaches establishing a date for a new product launch (Rosnow, ¶ 0046, wherein each project has a timeline associated with it and each task in a project has a due date; ¶ 0008, discussing a time before reaching product launch, at least suggesting that the time of product launch is a known element); determining a period in advance of said date to complete an associate selection process for assignments applicable to said

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new product launch (§ 0113, discussing timelines further; pg. 21, claim 11, stating that timelines are received for personnel to complete task assignments); and within said period identifying, selecting, and arranging for the group of candidates to complete the assignments, for which specifications are determined, and after said period, launching said new product (§ 0041, discussing that members of the team are assigned to develop the concept to launch; § 0079, Figs. 1–3, discussing and showing the task-based process from start to finish in the idea generation, verification, development and execution to ready for launch of the new product, especially Fig. 1, ref. 132, Initial project planning & task assignments in timeline, refs. 130–31, creating timelines for phases II and III of the project; §§ 0002, discussing idea being developed through launch and the tasks necessary to complete said venture; §§ 0082–83, 161 discussing phase III, including the tasks required to roll out the product to customers and to get the product on the shelf once all the idea, development, and testing related tasks from phase I and II are completed by various team members).

Regarding the arrangement of expatriate candidates to complete the assignments abroad, Harvey at least suggests this concept (pg. 106, “One major MNC, Walt Disney Co., failed to take the cultural sensitivity issue into account when they were selecting expatriate managers for EURO their Disney project. In hindsight, executives of Disney attribute a large portion of the failure today of the project on not sending the “right” managers to France.”). This passage at least suggests an arrangement for the expatriate candidates to complete their assignments outside their home country in that Disney selected expatriate managers for its EURO project, it sent these managers to Europe to work on the project, the EURO project subsequently failed, and that a large part of the failure was attributable to the selected expatriate managers, indicating that they

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performed work on the project in an expatriate capacity. For disclosure of selection of candidates for expatriate assignments, see Harvey, pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Selection.

Regarding arranging for the return home of the expatriate candidates, Harvey also at least suggests this via its discussion of the corporate investment and consideration in returning expatriates following and during execution of expatriate assignments, whether it's early (e.g., due to a failure and therefore costly, or a periodic trip back home) or timely (e.g., potentially advancing the career of the expatriate and benefit the company) (pg. 113, "The candidate's decision to relocate centers on . . . impact on career and career path . . . acceleration of advancement after returning from foreign assignment; pg. 103, "returning early to domestic organization"; pg. 104, "just as important are the implicit costs of . . . premature return to the domestic organization; pg. 113, "If there is no sustaining dimension to the candidate's motivation, the probability for burnout, early return and failure are increased"; pg. 112, "The family life-cycle will influence allowances particularly as related to travel, housing, educational costs, and return trips to the home market. There are also repatriation issues that increase the intricacy of families with children in certain stages of the family life-cycle.").

With respect to the type of assignment in the new product launch being expatriate in nature according to the process taught by Harvey, Mayer, and Applicant's Admitted Prior Art as discussed above, because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is in the substitution of expatriate assignment process taught by Harvey, Mayer, and

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Applicant's Admitted Prior Art for the particular product idea-to-launch assignments taught by Rosnow. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious, providing increased efficiency and chance of success in the event a product has to be launched overseas by going through a rigorous expatriate assignment selection process.

Regarding the period being one of years, Rosnow does not explicitly teach this. However, both Harvey and Mayer teach the concept of an occurrence or non occurrence for period of years in advance of a determination or action (Harvey, pg. 112, “The practice if using psychological evaluation has been used for a number of years by MNCs”; Mayer, ¶ 0074, “the candidate must not have had any speeding tickets in the past two years”).

As such, because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is in the substitution of a period of years, taught by Harvey and Mayer, for the general time period taught by Rosnow. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious, providing the benefit of ensuring that the expatriate selection process is not rushed, therefore enabling the best candidates to be selected and offering the best chance for successful completion and profitable roll out of the new product.

5. As per claim 2, Harvey teaches creating an assignment plan for at least one expatriate candidate (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage One:

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Policy level, Corporate Goals, Position Requirements/Criteria).

6. As per claim 4 neither Harvey nor Mayer explicitly teaches wherein providing each of said plurality of candidates with preview information regarding said expatriate assignments comprises providing each of said candidates with a realistic job preview video. However, Official Notice was taken, and not since adequately traversed by Applicant, that providing job preview videos was old and well known in the art of job recruiting at the time of the invention. Thus, this feature is considered Applicant's Admitted Prior Art. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Harvey in view of Mayer to include the teaching of Applicant's Admitted Prior Art for the benefit of providing the candidate with a more realistic and accurate depiction of the prospective position and therefore increasing the chances of procuring truly interested and committed candidates who will not drop out before completion of the assignment.

7. As per claim 5, neither Harvey nor Mayer explicitly teach wherein receiving identifying information for a first set of candidates from said plurality of associates comprises determining which associates have decided to not proceed. However, Official Notice is taken, and has not since been adequately traversed by Applicant, that dropout candidates and their determination was old and well known in the art at the time of the invention. Thus, this feature is considered Applicant's Admitted Prior Art. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Harvey in view of Mayer to include the teaching of Applicant's Admitted Prior Art for the benefit of saving an organization money by preventing

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the overseas assignment of an unwilling or unmotivated person.

8. As per claim 6, Harvey teaches wherein said assessments comprise motivational (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Motivational Career Path), behavioral (*id.*, Interpersonal Skills, Stage of Family Life-Cycle/Career Cycle), cultural (*id.*, Cultural Adaptability/Flexibility), and technical (*id.*, Part Performance/Technical Competence, Leadership/Decision Making Style) assessments.

9. As per claim 7, Harvey does not explicitly teach wherein establishing a development plan for each candidate in said group of expatriate candidates comprises establishing development plans according to gaps identified from said motivational, behavioral, cultural, and technical assessments. However, in stage 3 of its selection process (Exhibit 1, pg. 111–113), the method of Harvey determines these capability gaps identified from said motivational, behavioral, cultural, and technical assessments by weeding out unqualified or unable candidates that fall short of certain capabilities or characteristics. Furthermore, development plans for expatriate assignment candidates are old and well known as taught by Harvey as discussed above in the rejection of claim 1. Therefore, applying the known results of a gap analysis to a development plan would have been obvious to one of ordinary skill in the art to achieve a predictable result and result in an improved system that provides candidates with a better chance at improvement and success in the future by identifying the aspects of their capabilities that need the most improvement.

10. As per claim 8, Harvey teaches wherein at least one of said assessments is a self-

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assessment (pg. 112, discussing the administration of personality and psychological standardized tests to candidates to determine whether they are right for the position).

11. As per claim 10, the only difference between claim 1 and claim 10 is the reiteration of its method steps to produce additional sets of expatriate candidates and identifying and selecting candidates for *a plurality of* expatriate assignments. However, mere duplication of the parts of a method has no patentable significance unless new and unexpected result is produced. In re Harza, 124 USPQ 378 (CCPA 1960). Claim 1 is rejected above by Harvey in view of Mayer further in view of Applicant's Admitted Prior Art further in view of Rosnow. Therefore, it would have been obvious to modify these references to include these reiteration features to produce a predictable result and result in an improved system that provides for a more rigorous selection process and thus improves the chances of picking the right person for the assignment.

12. Claims 12, 15, 16, 17, and 18 recite limitations that stand rejected via the art citations and rationale applied to claims 2, 6, 8, 1, and 4 respectively as discussed above.

13. As per claim 19, Harvey in view of Mayer further in view of Applicant's Admitted Prior Art further in view of Rosnow teaches the method of claim 10 wherein identifying a set of candidates comprises: providing each of a plurality of associates with preview information regarding a plurality of expatriate assignments (*see discussion supra ¶¶ 11, 4*); and determining which associates have reviewed said preview information and withdrawn voluntarily from further consideration (*see discussion supra ¶ 7*).

Response to Arguments

14. Applicant's arguments with respect to claims 1–2, 4–8, 10, 12, and 15–19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Pats whose telephone number is (571)270-1363. The examiner can normally be reached on M-F, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Justin M Pats/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623